

Application No.: 10/614,008

**REMARKS**

Claims 1-10 are pending, with claim 1 being the sole independent claim.

The Examiner has maintained the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Sato in view of Okumura based on the allegation that "Sato ... discloses that [the alleged battery pack 12] is slidable from initial position to final as described in the associated drawing of Sato (sliding motion directed by the arrow in Fig. 4A, b)" (see page 7, lines 8-11 of outstanding Office Action). From the Examiner's basis for maintaining the pending rejection, it appears the Examiner has misunderstood Applicants' previously filed arguments.

Specifically, Applicants did not argue that the alleged battery pack 12 of Sato "is NOT movable" *per se* as asserted by the Examiner. Rather, Applicants argued that the alleged battery pack 12 of Sato is not movable *once the alleged external terminal 14 has already been inserted in the alleged inserting part*. The battery pack of Sato is indeed movable in effecting the connection between terminals 14 and 16, but such a connection is effected by a *single* motion. In contrast, as recited in claim 1, the claimed battery pack is configured to be "movable from an initial position to a fixing position *while* said external terminal *has been inserted* in said inserting part" so as to embody two motions; namely, insertion of the external terminal in the inserting part and the movement from the initial position (i.e., when external terminal is already inserted in the inserting part) to the fixing position. The Examiner does not address this issue.

Turning back to Sato, the relied on motion of Sato which the Examiner reads on the claimed "movable" refers to the insertion of the alleged external terminal 14 in the inserting part. However, *after* the alleged external terminal 14 of Sato has been inserted in the inserting part, the alleged battery pack 12 of Sato is no longer "movable from an initial position to a fixing position [wherein the] connection between said external terminal and said discharge terminal

**Application No.: 10/614,008**

being achieved at said fixing position." Indeed, the connection between the terminals 14 and 16 of Sato is already made when the external terminal 14 is inserted in the inserting part so that no further motion is needed.

In sum, the present invention as recited in claim 1 embodies two-motions for achieving a connection between the terminals (page 5, lines 6-19 of Applicants' specification) so that the external terminal is first inserted in the inserting part and then the second motion from the initial to fixing position is made while the external terminal has already been inserted in the inserting part. In contrast, Sato expressly uses a single motion so that once the alleged external terminal 14 has been inserted in the inserting part, whereby the connection is made, there is no further movement for effecting the connection between the terminals.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In

**Application No.: 10/614,008**

addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, regarding claim 10, it appears the Examiner is relying on the two motions "a" and "b" illustrated in Figure 4A of Sato as corresponding to the claimed motions corresponding to the battery pack being slidable from the initial position to the fixing position, and, the motion related to the initial insertion of the external terminal in the inserting part. However, motion "b" of Sato relates to the removal of the alleged battery pack 12 (col. 2, lines 62-64) so as to effect a *disconnection* of the terminals, and is therefore unrelated to the two-motion *connecting* sequence for the battery pack of the present invention.

Regarding claim 9, which stands rejected under 35 U.S.C. § 103 as being unpatentable over Sato in view of Haga et al. '686, it is submitted that Haga is not prior art to the present application (effective date of Haga is October 7, 2002 whereas the present application claims priority to July 16, 2002). Submitted herewith is a certified English translation of the foreign priority document for the present invention so as to perfect Applicants' claim to foreign priority.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

**CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

**Application No.: 10/614,008**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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